

**RECEIVED
CENTRAL FAX CENTER****APR 24 2007****REMARKS**

In this application, claims 1-67 are pending. The pending Office Action makes both restriction and election requirements, and Examiner Ramana is thanked for her telephone call concerning them. For at least the reasons detailed below, Examiner Ramana is respectfully requested to reconsider and withdraw these requirements.

The restriction requirement identified two groups of claims, characterized as follows:

- I. Claims 1-36, drawn to a method, classified in class 606, subclass 86.
- II. Claims 37-67, drawn to a system, classified in class 623, subclass 17.15.

The above language concerning the Examiner's groups is taken verbatim from the Office Action for the sake of clarity, and is not intended as an admission of any sort by Applicant as to the subject matter or classification of any claim.

As the restriction requirement relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, per standard PTO practice noted in MPEP 803 and 808.02 this application should be examined as a whole if it can be done without undue burden on the examiner.

Accordingly, Applicants elect group II (claims 37-67) for prosecution, with traverse on the grounds that searching and examining the entire application can be made without serious burden.

The Office Action relies on MPEP 806.05(e), and asserts that the claimed apparatus can be used in a process materially different from the claimed method, insofar as the apparatus can be used to practice a method not involving placing a bone filler material. However, that reasoning cannot apply to independent method claim 19, which does not include placing a bone filler material. Further, per MPEP 803 and 808.02, a restriction requirement should be withdrawn and all pending claims should be examined if it can be done without significant

RESPONSE TO RESTRICTION AND
ELECTION REQUIREMENT
Application Ser. No. 10/717,693
Atty. Docket 4002-3430

additional burden on the Examiner. Respectfully, the searching required for proper examination of one set of claims, e.g. the system claims, is clearly also needed for the other set of claims. It is believed that any examination of system claim 37 will concern references relevant to claims 1 and 19. Accordingly, the burden required for examining both sets of claims will not be substantially or significantly greater than the burden required for proper examination of one set of claims, and therefore the requirement should be withdrawn.

The requirement for election of species is also traversed. Examiner Ramana indicated her opinion that the present application includes claims directed to the following species:

<u>Species</u>	<u>Figure</u>	<u>Species</u>	<u>Figure</u>	<u>Species</u>	<u>Figure</u>
1	1	3	22	5	26A-26B
2	21	4	23	6	35A-35B

The above language concerning Examiner Ramana's categorization is taken verbatim from the Office Action for the sake of clarity, and is not intended as an admission of any sort by Applicants as to the subject matter of any claim. The Examiner requested an election between these asserted species, and observed the genericness of claims 37 and 41.

It is respectfully submitted that the election requirement should be withdrawn, principally because a proper *prima facie* case for it has not been made. The sole basis for the requirement was that the alleged species "have different structural characteristics and modes of operation." However, no basis for that conclusion were given in the Office Action. "The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate." MPEP

RESPONSE TO RESTRICTION AND
ELECTION REQUIREMENT
Application Ser. No. 10/717,693
Atty. Docket 4002-3430

808.01 (emphasis added); see also MPEP 803 (reasons and/or examples must be provided to support conclusions). No citation to the application, discussion of the embodiments, or other evidence or grounds for her conclusion were provided. Because the MPEP defines a conclusion of restrictability without basis to be inadequate, the requirement should be withdrawn.

Further, the similarities among the embodiments are such that they can all be efficiently considered together when the claims are searched and examined. If "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions." MPEP 808.02. The Office Action does not allege that the classification of the alleged species is different, and it seems likely that all such species would be commonly classified. Clearly the same art categories would be consulted for each alleged species. It is not apparent from the record that any searching would be necessary for one species "that is not likely to find art pertinent to the other[s]." *Id.* Rather, it is believed that any practical search strategy for one species would find references pertinent to all species. Finally, no suggestion was provided that the alleged species would be separately classified or searchable in the future. No patents or other evidence of a separate field of search was provided, as MPEP 808.02 requires. For these additional reasons, the election requirement should be withdrawn.

The Examiner has further requested a listing of the pending claims that read on the provisionally-elected species. That request is respectfully objected to as improperly devolving the responsibilities of the PTO onto the Applicants. The PTO has the burden of proof to provide evidence and a sufficient showing that claims in an application are unpatentable, or should otherwise be excluded from an application.

RESPONSE TO RESTRICTION AND
ELECTION REQUIREMENT
Application Ser. No. 10/717,693
Atty. Docket 4002-3430

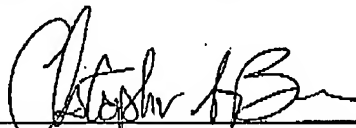
Page 4 of 5

So as to give a complete response for the sake of efficiency, species 1 (relating to Figures 1-20) is provisionally elected, with traverse. At least system claims 37-52 and 55-65 read on those drawings and are supported by the text associated with them. With respect to claims 46 and 60, it is noted that the embodiments of those drawings include stepped configurations (see Figures 11-14 and pages 9 and 14 of the specification). Independent claims 1 and 19 and some or all of their dependent claims also are supported by the use of the apparatus in Figures 1-20.

Applicants do not concede the propriety of the Examiner's request, and do not intend to limit in any way the scope of the claims with the statements or provisional election herein. Specifically, the claims in this application should be given the full scope permitted by their language. Applicants reserve the right to later assert that other claims are generic or read on the provisionally-elected species as well, especially if the election requirement is not withdrawn. No amendments have been made to the claims, and no new matter has been added.

In conclusion, provisional elections as noted above are made with traverse. Examiner Ramana is respectfully requested to reconsider these restriction and election requirements and withdraw them. A new Office Action toward a Notice of Allowance is respectfully solicited.

Respectfully submitted,



Christopher A. Brown, Reg. No. 41,642
Woodard, Emhardt, Moriarty,
McNett & Henry LLP
Chase Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

#459737

RESPONSE TO RESTRICTION AND
ELECTION REQUIREMENT
Application Ser. No. 10/717,693
Atty. Docket 4002-3430

Page 5 of 5